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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,182	02/10/2000	Sivan Tafla	10980/010001/122315.5	4849

20529 7590 04/01/2004

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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/502,182

Applicant(s)

TAFLA, SIVAN

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/3/03, 7/2/03, 12/10/03, 1/6/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45, 47, 49 and 51-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45, 47, 49 and 51-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 21.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the paper(s) filed 6/3/03, 7/2/03, 12/10/03, 1/6/04.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 5, 15, 27 and 39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

- There is no enabling disclosure for providing an animated video clip which travels across the screen. While vector animation such as Flash provides the artisan with methods to provide animation, an enabling disclosure concerning animating a video object is not provided. Applicant's disclosure is rather abrupt and merely mentions that "whilst animation is created using vector graphics, the invention also contemplates use of video clips" (page 8 lines 10-13); no teachings or examples are provided on how to accomplish such a task. Applicant argues how the video clip animation can be accomplished, yet the minimal original disclosure does enable of ordinary skill to accomplish such.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-45, 47, 49, 51-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Zapa Digital (WO 97/35280) in view of Sony (WO 98/47090).

Regarding claims 1, 12, 45, 47, 49, 51-53, Zapa Digital teaches systems and methods for downloading an animated layer from a server which is taken to be animated content embedded in a web page layer, the animated layer being rendered and superimposed over a web page shown in a web browser (e.g. yahoo! Webpage) [fig 2, 6A, 6B, pg 25 lines 23-25]. Zapa Digital describes the animation as advertising content [pg 32 lines 30-31]. The animated object(s) move across the screen portions [pg 25 line 35 to pg 26 line 5, pg 17 lines 19-25] and the web page underneath is fully active and responsive, save for the portion covered by the boundary of the animated object. The animation (Smart Object) is a web page/browser file (such as HTML or VRML) that is separate from the underlying displayed web page, but layered on top of it [pg 4 lines 14-17, pg 6 lines 12-17, pg 7 lines 1-6, pg 10 line 1-5]. The animation can be triggered internally by the Smart Object animation file, or by an external trigger such as a Scene Manager, or a JAVA applet provided by a server [pg 6 lines 26-28, pg 18 lines 7-13]. Zapa's advertisements are not described as interstitial. Sony teaches methods

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for interstitially providing advertisements to a user browser during idle periods. After a user downloads a web page, the client is idle while the user reads the page. During this time the browser calls for an advertisement to be downloaded to the client. When the user navigates to a new page, the downloaded ad content is displayed. It would have been obvious to one of ordinary skill at the time of the invention to have transferred Smart Object animation files to the requesting client computer of Zapa during idle web browsing periods and triggered them during interstitial periods, as taught by Sony so that animated ads can be politely displayed to give the user something to read while the successive page is retrieved and loaded.

Regarding claims 4, 7-9, 17, 18, 21-26, 29-31, 33-38, 41-43, Zapa Digital teaches that the triggering of various animations can be accomplished by programming integral with the animation object itself, or by external, programmed scripts [pg 18 lines 7-13]. The animations can be triggered without interaction by the user, such as proximity of one character in relationship to another or collisions, or by user-action such as mouse selection [pg 6 lines 24-36, pg 23 lines 22-26]. Zapa Digital also teaches animations to be triggered by the server through the use of a downloaded mobile program (JAVA server applet) [pg 34 lines 29-31]. Regarding claim 14, the server's processor which sends the JAVA-based triggers is inherently responsive to a clock.

Regarding claims 5, 15, 27 and 39, the animation portions are taken to be "video clips", as they are visual portions of displayed motions.

Regarding claim 6, 16, 28 and 40, the smart objects that comprise the animated objects are taken to be animated by way of vector scripts. The objects include

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mathematical descriptions of the image element as well as data describing the position, orientation and motion of such object from one animation frame to the next [pg 4 lines 18-20, pg 5 lines 3-8, pg 6 lines 29-31].

Regarding claims 11, 20, 32 and 44, Zapa Digital describes portions of the animated objects as partly transparent (translucent) so that the underneath content is visible [pg 25 lines 21-25].

Regarding claims 2 and 3, Sony teaches that the advertising content can come from the server as the requested content, or from a different server [pg 5 lines 8-11].

Regarding claims 5, 15, 27 and 39, it would have been obvious to one of ordinary skill at the time of the invention to have provided any type of known digital animation formats with the moving objects of Zapa Digital, including video clips and animated gifs, for example, so as to provide a wide variety of enticing advertising. Further, applicant provides no criticality to the types of format, be it vector-based or video clips. Applicant's claiming of either type of format suggests a lack of criticality to this feature.

6. **Claims 1-45, 47, 49, 51-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Sony in view of Zapa.** Sony teaches interstitial advertising content that is displayed to used during web surfing. Zapa teaches animation methods to provide an animated advertising layer on top of user-requested web pages. It would have been obvious to one of ordinary skill at the time of the invention to have provided interstitial advertising to web surfers, as taught by Sony, but in an animated, layered format as taught by Zapa, so that the interstitial advertising content is enticing and dynamic.

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill would be motivated to provide such animated ads in a politely displayed manner (interstitially) to give the user something to read while the successive page is retrieved. Applicant argues that the instant invention triggers display of the ad independent of the web page. The Zapa et al ads shown on top of web pages present in the client browser are independent of the web page. Likewise, the suggested triggering is not defined or dependant on the web page content, but rather the client navigation.

Applicant argues a "third party service" and includes "uploading" and "downloading" in the claims. No claim language is present regarding a third party. No distinction is made by the examiner regarding any difference between upload and download meanings. If applicant desires distinct meaning, more details should be claimed regarding the requestor and recipient of the files, or perhaps the direction of files sent, or perhaps steps set forth from a particular party's prospective. As the claims stand, "upload" and "download" are taken to require only "transfer".

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Applicant argues that the webpage layer is separate from the web page. Such is true with Zapa et al. Zapa et al teaches that the animation object/file is VRML, JAVA, HTML or other format compatible with an Internet browser [10:1-5]. This ad content which is overlaid on top of web pages at the client is taken to be a web page layer having embedded animation content. The animation object (layer) is overlaid on top of another application such as a browser (web page) [4:14-16]. A browser plug-in receives animation objects over the network and then renders the animation objects overlaid on the browser [6:13-17]. A human walks across a window created by some other software application, such as an Internet browser (or word processor) [7:1-5]. Clearly, the overlaid animation layer is independent of the web page visible beneath it.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc